

# Saint Lucia

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## 1 Ownership of marks

### Who may apply?

A person or legal entity may apply if that person is the owner of the trademark, is using or intends to use the trademark.

## 2 Scope of trademark

### What may and may not be protected and registered as a trademark?

The following may be registered as trademarks in Saint Lucia: letters, words, names, signatures, numerals, devices, brands, headings, labels, tickets, aspects of packaging, shapes, colours and any combination of these. No clear distinction is made in the Trademarks Act in respect of service marks. Service marks are considered trademarks associated with services and are registered in the same manner as trademarks for goods. Non-traditional marks such as sounds and smells cannot be registered in Saint Lucia, as the law does not provide for their protection.

## 3 Common law trademarks

### Can trademark rights be established without registration?

Trademark rights may be established without registration and said rights are protected under the common law tort of 'passing off'. Passing off claims are costly, consequent on the volume of evidence necessary to support a passing off claim.

## 4 Registration time frame and cost

### How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

A trademark registration takes approximately six months from application to registration. The total cost of registering a trademark in a single prescribed class is US\$1,530.00, inclusive of Agent and Official Fees. The fee would increase if the application is in respect of more than one prescribed class and if the mark is a combined mark or a logo, as the publication costs are increased in such cases.

An authorisation of agent is a requirement of the trademark registration process and must be filed within six months of making the application. The cost of the authorisation of agent is captured in the total cost of registration of the trademark.

## 5 Classification system

### What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The classification system followed in Saint Lucia is the Nice Classification, as Saint Lucia is a party to the Nice Agreement and is obligated to adopt and apply the said classification for the purpose of

registration of trademarks. Multi-class applications are available and there is an approximate 50 per cent saving on each additional class registered.

## 6 Examination procedure

### What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The Registrar carries out a substantive examination and issues a report if he or she believes there are grounds for rejecting an application. The Registrar examines the representation of the trademark to ensure that it meets the criteria for distinctiveness as well as the specification of goods or services to ensure that they accord with the Nice Classification. Applications are also examined for potential conflicts with other trademarks. The letter of consent is not specified in the Trademarks Act of Saint Lucia; however, it has been used in the review of trademark applications after rejection if the parties indicate that the owners of the respective trademarks are affiliated entities.

If in the course of an examination of an application the Registrar reasonably believes that the application has not been made in accordance with the Act or the Regulations, or there are grounds for rejecting the said application, the Registrar must report that belief in writing to the applicant. Applicants are given the opportunity to respond to objections raised by the trademark office. The response may contest the Registrar's belief expressed in the report; contest any other matter arising out of the report; provide further documentary evidence in support of the application; or request that the application be amended in accordance with the Act.

## 7 Use of a trademark and registration

### Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Foreign applicants may claim priority rights when making an application for registration of a trademark in Saint Lucia should the same application have been filed in one or more than one Convention country and provided that the Saint Lucia application is made within six months after the day on which that application, or the first of those applications, was made.

The applicant must file notice of the claim, which notice must specify in respect of the earlier application or, if there is more than one earlier application in respect of each earlier application, the Convention country in which the earlier application was filed, the date on which the earlier application was filed and the number (if applicable) of that earlier application. The claim for priority should be made when filing the application, although the certified copy of the application of which

priority is claimed can be furnished to the Registrar within six months of making the application.

## 8 **Appealing a denied application**

### **Is there an appeal process if the application is denied?**

The nature of the objection and the stage at which the objection is raised dictates how an appeal will proceed. Should the objection of the Registrar be raised at the examination stage and relate to the specification of goods and services or a clerical error or obvious mistake, the applicant will be granted the opportunity via a further application to convince the Registrar otherwise or to effect amendments or corrections to the application at that stage.

The applicant may also appeal to the High Court against any decision of the Registrar that leads to the subsequent rejection of an application.

## 9 **Third-party opposition**

### **Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?**

Any person may oppose the registration of a trademark by filing a notice of opposition with the Registrar within three months from the day on which the acceptance of the application is published in the Official Gazette.

The Trademarks Act of Saint Lucia prescribes the grounds on which an opposition may be made, which grounds are similar to the grounds on which the Registrar may reject an application under the Act, except on the ground that the trademark cannot be represented graphically. Registration of a trademark may be opposed on the following grounds:

- the applicant is not the owner of the trademark;
- the applicant does not intend to use or authorise the use of the trademark, or to assign the trademark to a body corporate;
- the opponent claims earlier use of a similar or identical trademark;
- the trademark is substantially identical with or deceptively similar to a trademark that has acquired a reputation in Saint Lucia and because of the said reputation of the other trademark the use of the first-mentioned trademark would be likely to deceive or cause confusion;
- the trademark consists of a false geographical indication;
- the application was amended contrary to the Act;
- the application contains certain signs prescribed by the Act not to be used as a trademark;
- the trademark does not distinguish the applicant's goods or services;
- the trademark is scandalous or its use contrary to law; or
- the trademark is likely to deceive or cause confusion.

The opponent must file with the registrar the notice of opposition, which must outline the grounds for the opposition. The opponent must also serve a copy of the notice of opposition on the applicant and file a statement setting out the particulars of service on the applicant within two days after service of the notice. An extension of time to file a notice of opposition may be sought from the Registrar. If the opponent intends to rely on evidence in support of the opposition, the opponent must serve a copy of the evidence within three months from the day on which the notice of opposition is filed.

Likewise, if the opponent does not intend to rely on evidence in support of the notice of opposition, he or she must, within three months from the day on which the notice of opposition is filed, serve on the applicant notice that the opponent does not intend to rely on evidence. If the opponent does not file evidence in support of the notice of opposition, or notice that he or she will not rely on evidence, or apply for extension of time, the opponent is deemed to have abandoned his or her opposition.

If the applicant intends to rely on evidence in answer to the opposition, the same procedure applies with respect to the time frame for

servicing a copy of the evidence in answer. The applicant must also file the original evidence with the Registrar within two days after serving a copy on the opponent. If the applicant does not intend to rely on evidence in answer to the opposition, the same procedure applies with regard to serving a copy of a notice that he or she does not intend to rely on evidence in answer. If the applicant does not file evidence in answer, or the notice that he or she will not rely on evidence in answer or, apply for an extension of time to do so, he or she is deemed to have abandoned his application. If the opponent intends to rely on evidence in reply to the evidence in answer to the opposition, the same procedure applies as stated above.

Upon completion of the evidence, the applicant or opponent may ask the Registrar to hear the parties to the opposition proceedings and the Registrar shall honour the request. Unless the proceedings are discontinued or dismissed, the Registrar shall decide – to refuse to register the trademark; or to register the trademark with or without conditions or limitations. An applicant or opponent may appeal to the High Court against a decision of the Registrar. No restrictions exist as regards who may oppose a trademark.

The cost of filing a notice of opposition is approximately US\$1,000.00 and the cost of filing cancellation of proceedings is approximately US\$400.00 (both inclusive of Agent and Official Fees).

## 10 **Duration and maintenance of registration**

### **How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?**

The trademark registration remains in effect for 10 years from the date of filing the application and may be renewed for further 10-year periods. A person may request the Registrar to renew the registration of a trademark six months prior to the day on which the registration of the trademark expires. If a request for the renewal of the registration is made the Registrar shall renew the registration for a period of 10 years from the day on which the registration of the trademark would expire if it were not renewed. The cost of filing a renewal of a trademark is approximately US\$1,250.00 per single class, inclusive of the cost of the certificate of renewal.

Proof of use is not required for maintenance unless the trademark registration is challenged.

## 11 **The benefits of registration**

### **What are the benefits of registration?**

A registered trademark is personal property and is conclusive evidence of the ownership of the trademark. The registered owner of a trademark has the exclusive right to use the trademark and to authorise others to use the trademark in relation to the goods and services particularised in the registration. Trademark registration deters potential infringers and makes it easier to obtain relief against infringers, as the Trademarks Act provides wider protection to the registered owner compared with the common law remedy of passing off. For example, the Trademarks Act provides for the registered owner of a registered trademark to give to the Comptroller of Customs a notice objecting to the importation (after the date of the notice) of goods that infringe the trademark, which notice remains in force for two years from the day on which the notice is given unless it is revoked before the end of that period by notice in writing given to the Comptroller. The owner of a registered trademark would not need to show use of the trademark, reputation or goodwill should there arise an infringement of the mark, as in an action for passing off.

## 12 **Licences**

### **May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?**

Licences are not expressly dealt with under the Act. However, they would be deemed an interest in or a right in respect of a trademark and would be dealt with in the same manner as would security interests discussed in question 16. Under the Act a person who claims an interest in and to rights in respect of a trademark may by application in the

prescribed form record the particulars of the claim with the Registrar. The Act places no obligation on the Registrar to take any action in respect of notifying third parties of any claims, duly recorded, to an interest in a trademark.

The Licensee for the purposes of the Act is an 'authorised user of a trademark' and may take certain actions in respect of the registered trademark should the registered owner fail in his or her obligation to do so. Unless and until the Licensee records his or her interest in the trademark with the Registrar, the benefits afforded under the Act (eg, asking the registered owner to give notice of objection to importation of goods that infringe the trademark to the Comptroller of Customs or alternatively to give the requisite notice in the event the registered owner fails to do) cannot be realised.

### 13 Assignment

#### What can be assigned?

Registered trademarks can be assigned with or without goodwill.

Under the Act, an assignment can be partial in that it may apply to only some of the goods and services under the trademark. However, the assignment may not be partial in relation to the use of a trademark in a particular area. There is no requirement under the law that other assets need to be assigned as part of the trademark assignment to validate the transaction.

A collective trademark cannot be assigned.

A certification trademark can only be assigned with the consent of the Registrar.

### 14 Assignment documentation

#### What documents are required for assignment and what form must they take?

The documents required for assignment are:

- a document that establishes the title to a trademark of the assignee, or evidence of the assignment of a registered certification mark; and
- an Application for Recordal of Assignment or Transmission of Trademark pursuant to the Trade Marks Regulations.

The document evidencing the assignment must be an original or notarised copy.

### 15 Validity of assignment

#### Must the assignment be recorded for purposes of its validity?

Pursuant to the Trade Marks Act, if a registered trademark is assigned the person registered as the owner of the trademark or the person to whom the trademark has been assigned shall apply to the registrar for a record of the assignment to be entered in the Register. If the said application complies with the Act the Registrar shall:

- (i) enter the particulars of the assignment in the Register;
- (ii) register the person to whom the trademark has been assigned as the owner of the trademark in relation to the goods and services or both in respect of which the assignment has effect; and
- (iii) publish notice of the recording of the assignment and the registration of the beneficiary as the owner of the trademark in the Gazette.

### 16 Security interests

#### Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

The Act recognises the voluntary recording of claims to interests in and rights in respect of the trademark and provides for the recording in the Register of such claims that may not be recorded otherwise under the Act; and for the Registrar to keep a record thereof. Security interests would, for the purpose of the Act, fall under this general heading of interests in and rights in respect of trademarks.

If a person other than the registered owner of the trademark claims to have an interest in, or a right in respect of, a registered or unregistered trademark other than by an assignment or transmission of the said trademark; a joint written application must be made to the Registrar by the person claiming the interest and the registered owner of the trademark to have the particulars of the claim recorded. In the

case of a registered trademark the Registrar shall enter the particulars in the Register; in the case of an unregistered trademark the Registrar shall record in the manner that the Registrar thinks fit, but not in the Register.

Such interests being creatures of agreement or operation of law there is no requirement for notarisation imposed by the Act. The recordal of such interests is voluntary and the validity and enforceability of such interests are not contingent on them being recorded.

### 17 Markings

#### What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Markings are not mandatory in Saint Lucia and the Act does not prescribe words or symbols that can be used to indicate trademark use or registration. The word 'registered' is used by the IP Office (Saint Lucia) in the Trademark Register to indicate that a trademark is duly registered. The obvious benefit would be that the word, device or logo would be specifically identified as a trademark, and this could deter potential infringers.

### 18 Trademark enforcement proceedings

#### What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Apart from through opposition and cancellation proceedings, the Trade Marks Act protects registered trademarks owners by providing for the Comptroller of Customs to effect seizure and deal with goods that are imported into Saint Lucia if the importation infringes, or appears to infringe, a trademark registered in Saint Lucia.

There are no specialised courts or tribunals in respect of trademarks in Saint Lucia. Consequently, legal proceedings regarding the enforcement of rights of a trademark owner must be commenced in either the civil or criminal courts. Civil proceedings must originate in the High Court and criminal proceedings in the magistrates court or the High Court, depending on the size of the claim.

The Act specifies the various criminal offences that could arise in respect of trademarks and the various penalties that may be imposed once there is contravention of these sections of the Act.

### 19 Procedural format and timing

#### What is the format of the infringement proceeding?

Trademark infringement proceedings are commenced like any other civil action in the High Court (Civil) by filing and serving a claim form and a statement of claim. All other pleadings are filed and served based on a prescribed schedule. The defendant is required to file and serve a defence and any counter claim applicable. Once a defence is filed a case management hearing will be scheduled by the court. The matter could at this stage be referred to a court-appointed mediator (by consent of the parties). Should the parties not agree to mediate then trial directions will be given and the matter escalated to trial. The Case Management Order defines how disclosure will be made and outlines the timetable by which the parties will progress the trial. Evidence is given via written witness statements with cross-examination and re-examination of witnesses.

Expert witnesses are permitted with the leave of the court. Expert evidence is given via witness statement with cross-examination and re-examination.

Skeleton arguments must be provided to the judge prior to the trial and pursuant to the Case Management Order.

The case is heard by a single High Court Judge.

The time frame of the hearing depends on a number of variables, including the complexity of the matter, and can last from one day to three days.

All criminal offences under the Act would be enforced by the Director of Public Prosecution, and would in the first instance be heard

in the magistrates' court. A decision of the magistrate may be appealed to the High Court.

## 20 Burden of proof

### What is the burden of proof to establish infringement or dilution?

The burden of proof in a civil action is on the balance of probabilities, and in a criminal action beyond a reasonable doubt.

## 21 Standing

### Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

A registered owner of a trademark has the exclusive right to obtain relief if the trademark has been infringed. If a trademark is registered in the name of two or more persons as joint owners of the trademark, the rights granted to those persons are to be exercised by them as if they were the rights of a single person.

An authorised user of a registered trademark may also bring an action for infringement of the trademark (subject to any agreement with the trademark owner) if the registered owner refuses or neglects to bring an action within the prescribed period.

The Act does not specify who may bring a criminal complaint; however, a registered owner or authorised user or an agent of an affected party would have standing to lodge a criminal complaint.

## 22 Foreign activities

### Can activities that take place outside the country of registration support a charge of infringement or dilution?

Under the Act, activities occurring outside of Saint Lucia (being the country of registration of the trademark) can support a charge of infringement or dilution. The objective of this provision is to protect registered trademarks by allowing the Comptroller of Customs to seize and deal with goods manufactured outside of Saint Lucia that are imported into Saint Lucia if the importation infringes, or appears to infringe, a registered trademark.

The registered owner or an authorised user of the registered trademark may give to the Comptroller notice in a prescribed form objecting to the importation of goods that infringe the trademark. The Comptroller must seize such goods unless satisfied that there is no reasonable ground for believing that the notified trademark has been infringed by the importation of the goods. Should the objector not bring an action for infringement and give notice to the Comptroller within the prescribed period, the Comptroller is obligated to release the seized goods to the designated owner.

## 23 Discovery

### What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Disclosure of documents is always pursuant to an order of the court. The judge typically orders standard disclosure, but may in his or her discretion order specific or other disclosure. Privileged documents such as 'without prejudice' correspondence do not have to be produced.

## 24 Timing

### What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

It is difficult to offer a typical time frame for litigating an infringement or dilution or related action as there are few if any such actions brought in Saint Lucia. The majority if not all such claims settle via mediation. Generally, the time period for litigation of civil claims in the High Court, from commencement of the claim to receipt of judgment in the matter, is approximately 12–18 months. The hearing of an appeal would conclude in a much shorter period: approximately 3–6 months.

## 25 Litigation costs

### What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The cost of litigating a claim for infringement or dilution of a trademark, including trial preparation, trial and appeal would be no different from the cost of litigating any civil suit and would be assessed pursuant to the Easter Caribbean Supreme Court Civil Procedure Rules 2000, the overriding objective of which is to deal with cases in ways that are proportionate to the amount of money involved, the importance of the case and the complexity of the issues, among other things. Part 65 of the said rules as amended deals with the ways in which costs are to be quantified, specifies a scale of fixed and prescribed costs and outlines percentages to be allowed at various stages of any claim from filing to trial.

## 26 Appeals

### What avenues of appeal are available?

An appeal lies to the High Court against a judgment or order of a lower court exercising jurisdiction under the Trade Marks Act. Appeals to the Court of Appeal against a judgment or order of a single judge of the High Court can occur with the leave of the Court of Appeal. Correspondingly, with special leave of the High Court, an appeal lies to the High Court under the Act.

## 27 Defences

### What defences are available to a charge of infringement or dilution, or any related action?

There are a number of defences available to a charge of infringement or dilution of a registered trademark, including:

- the defendant used the trademark in good faith;
- the defendant used the trademark for comparative advertising;
- the defendant used a sign in good faith to indicate the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic of the goods or services or the time of production of goods or of the rendering of services;
- the defendant used the trademark in good faith to indicate the intended purposes of the goods;
- the defendant exercised a right to use the trademark given to him under the Act;
- the court is of the opinion that the defendant would obtain registration of the trademark if he were to apply for it;
- the trademark has been applied to, or in relation to, goods by, or with the consent of, the trademark owner; or
- the defendant can show that he or she, or their predecessor in title, has continually used the trademark in relation to those goods or services from a time before the registration of the trademark or when the registered owner first used the trademark.

A person aggrieved by the threat of legal action for infringement of a registered trademark may also bring an action either in the High Court or in any other court having jurisdiction against the person making the threat to:

- (i) obtain from the court a declaration that the defendant has no grounds for making the threat;
- (ii) obtain from the court an injunction restraining the defendant from continuing to make the threat; or
- (iii) recover any damages that the defendant has sustained because of the defendant's conduct.

Groundless threats of legal proceedings in respect of infringement of registered trademarks should be avoided.

## 28 Remedies

### What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The relief available to a successful party in an action for infringement of a registered trademark includes the grant of an injunction, which may

**Update and trends**

A Trademarks Law Review Committee was installed in May 2018 comprising practitioners of trademark law to see to the review of the Trade Marks Act Cap 13:30 of the Revised Laws of Saint Lucia 2013. Recommendations resulting from said review have been referred to the Legislative Drafting Department of the Attorney General's Chambers for further review and adoption. Amendments to the Trade Marks Act of Saint Lucia are, therefore, imminent.

be awarded subject to any condition that the court thinks fit; delivering up or destruction of the infringing goods, at the option of the claimant; or damages or an account of profits and payment of legal costs.

Criminal remedies are available in respect of falsifying a registered trademark; falsely applying a registered trademark; manufacture and possession of a die for use in the commission of an offence in respect of a registered trademark; selling goods with false marks; making false representations regarding trademarks; making or causing a false entry to be made in the Register; disobeying a summons; refusing to give evidence; and acting in a trademark matter without due authority. A person who commits any of the above-mentioned offences is liable upon summary conviction to fines ranging from 250.00 East Caribbean dollars to \$250,000.00 East Caribbean dollars.

**29 ADR****Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?**

Mediation and arbitration (to a lesser extent) are both available to aggrieved parties to attempt resolution of their disputes by assisted negotiations outside of the more formal setting of the court.

Arbitration becomes operational in the event of a dispute if, by agreement, the parties have decided previously to pursue this medium.

There are several benefits to arbitration, including the specialised expertise of the arbitrator over that of a judge and potential time savings to the parties. The unavailability of trained arbitrators in Saint Lucia means that significant costs may be incurred by the parties to secure the services of an arbitrator, including travel and accommodation costs.

The courts in Saint Lucia favour settlement of disputes by mediation and there is a Court Connected Mediation Programme in place to assist in this regard. Mediation is usually recommended in the first instance by the court. A matter may, however, be referred to mediation only with the consent of the parties. The benefits to the parties of engaging in mediation are: a faster process, resulting in cost and time savings; an informal setting as compared to the court; and an opportunity for the parties to face each other and discuss their dispute in good faith with intent to settle. In Saint Lucia an agreement reached by mediation may be duly filed in the High Court, which decision is made an Order (by consent) of the court, thereby binding the parties.

The risk of using ADR techniques is that should the parties not reach agreement the matter must revert to the courts.

**30 Famous foreign trademarks****Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?**

If the famous trademark is not used or registered in Saint Lucia, the owner may nonetheless be able to pursue an infringement action under the common law tort of passing off. The owner will need to prove that the famous trademark is known to the Saint Lucia public and that there was an intention to deceive and or confuse and that he or she has suffered damage as a result of the said deception and confusion.



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